

Attorney Docket No.: 98.41CON

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Lawson, et al.

Serial No.: 09/441,832

Group Art Unit: 1619

Filed: November 17, 1999

Examiner: Berman, Alysia

For: Gel-Type Oil Free Cosmetic

#12
AKO
1-30-02PRELIMINARY AMENDMENT

Assistant Commissioner of Patents and Trademarks

Washington, D.C. 20231

Dear Sir:

The following Preliminary Amendment is submitted as a further response to the Final Office Action dated August 21, 2001 and the Advisory Action dated December 18, 2001. Applicants previously filed, on October 15, 2001, a response to the Final Office Action, which was considered but not deemed to place the application in condition for allowance. Concurrently herewith, Applicants file a continued prosecution application, and respond herein to comments made by the Examiner in the Advisory Action.

Claims 1, 7, 15, and 15 are rejected under 35 U.S.C. 112, second paragraph, because the terms "carbohydrate-based" and "sterol-based" are vague and indefinite. However, as pointed out in the decision of *Hockerson-Halberstadt Inc. v. Avia Group International Inc.*, 55 USPQ2d 1487, 1490 (CAFC 2000), a term may have a special meaning applied if the term is clearly defined in the specification because the patentee may act as a lexicographer and provide a different, or modified, meaning to the term. *Hockerson*, 55 USPQ2d at 1490 (citing *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998) (observing that an applicant, acting as a lexicographer, may bestow "a special meaning to a term in order to convey a character or property or nuance relevant to the particular invention"); *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1388, 21 USPQ2d 1671, 1674 (Fed. Cir. 1994)). The definition in the present specification is sufficient for one of ordinary skill in the art to understand the metes and bounds of this term of art. At page 4, "sterol-based surfactant or emulsifier" is defined as follows, "[u]seful sterol-based surfactant/emulsifiers include cholesterol and phytosterols, or derivatives thereof." Therefore, the claims are believed to meet the requirements of 35 U.S.C. §112, second paragraph, and Applicants request that this rejection be withdrawn.

Claims 1, 2, 7 to 11, and 14 remain rejected under 35 U.S.C. §102(b) as being anticipated by McEleney et al. (U.S. Pat. No. 5,567,420, hereinafter referred to as "the '420 reference"). According to the Examiner in the Advisory Action, the '420 reference does not require that the gels contain oil or that the gels are emulsions. The present invention is a non-emulsion gel-type composition comprising a polyhydric alcohol, an amine or alkali salt of a fatty acid ester, a surfactant/emulsifier, water, and substantially no oil. Specifically, as set forth in the present specification at page 4, lines 17 to 20, "substantially no oil" as used in the present specification means that the amount of oil is less than about 5 percent, or preferably less than about 3 percent. The substantial lack of oil in the compositions contributes to the creation of a non-emulsion state, and supports the desirable mousse texture. If an emulsion is formed, as described in the present specification at page 4, lines 16 to 20, the mousse texture of the present invention may be altered. The compositions of the present invention are novel because the '420 reference fails to disclose non-emulsion gel compositions containing substantially no oil.

Applicants previously in their Response of July 13, 2001 ("Applicants' Previous Response"), pointed out that the components of the non-emulsion gel of the present invention as they are arranged in the claims are not disclosed by the '420 reference. Anticipation requires "the presence in a single prior art disclosure of all elements of a claimed invention arranged as they are in that claim." *Carella v. Starlight Archery*, 231 USPQ 644, 646 (CAFC 1986)(emphasis added). Therefore, one of ordinary skill in the art would not be able to make a non-emulsion gel based on the disclosure of the '420 reference because it fails to describe a composition with substantially no oil like that of the present invention in relation with the other components.

The Examiner asserts that the '420 reference discloses all of the limitations of the present invention, and that one of ordinary skill in the art would understand from the teachings of the '420 reference that the compositions may be in the form of emulsions or gels, and that the '420 reference does not require that the gels contain oil. However, as previously discussed in Applicants Response of October 15, 2001, the '420 reference discloses just the opposite. The specific types of gels that are suitable for the alleged invention in the '420 reference are described at column 3, lines 34 to 38 as follows.

For topical use, it is desirable that a CI [color indicator] is dispersed in an emulsion of sunscreen or lotion and applied to the skin. For this purpose, the CIs are intended to be admixed in a pharmacologically acceptable topical carrier such as a gel . . .

Thus, contrary to the Examiner's assertion, the '420 reference discloses that its gels are emulsions, and one of ordinary skill in the art based on the disclosure of the '420 reference would understand that the gels of the '420 reference are emulsions. Therefore, the '420 reference fails to disclose a non-emulsion gel. Further, however, the '420 reference fails to disclose a gel composition that has substantially no oil.

The '420 compositions contain substantial amounts of oil, and in particular, contain greater than 5 percent oil, unlike the present invention. As previously mentioned, the present invention contains substantially no oil which means that they contain less than about 5 percent oil, and preferably, less than about 3 percent oil. The substantial lack of oil in the present compositions contributes to the establishment of a non-emulsion gel which is key to the mousse texture of the present invention. Contrary to the present invention, the '420 reference discloses oil containing compositions of greater than 5 percent oil. The '420 compositions are disclosed as containing a number of additional ingredients including emollients. As disclosed at column 5, line 52 to column 6, line 23, of the '420 reference, emollients include hydrocarbon oils, silicone oils, lanolin, and vegetable waxes. Specifically, the '420 reference discloses, *inter alia*, mineral oil, lanolin oil, cocoa oil and butter, jojoba oil, and vitamin E acetate. In addition, the '420 reference provides an exemplary lotion formula containing at least about 6 percent oils.

In Table 1, at column 9, of the '420 reference, a "Typical Lotion Formula" is provided wherein at least about 6 percent, and up to about 12 percent oil is disclosed in the formula. The oil disclosed in this formula is lanolin, cocoa butter, vitamin E acetate, aloe vera lipo quinone extract, jojoba oil, mineral oil, and

emulsion gel of the present invention containing substantially no oil. Under 35 U.S.C. §103, a case of *prima facie* obviousness requires, *inter alia*, that prior art references when combined teach or suggest the claimed subject matter to one of ordinary skill in the art. *In re Vaack*, 20 USPQ2d 1438, 1442 (CAFC 1991); *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). As the amounts of oil in the '420 compositions are greater than 5 percent, the '420 reference fails to teach or suggest non-emulsion gels the ability to maintain a non-emulsion decreases as the amount of oil increases. Therefore, one of ordinary skill in the art would understand that the '420 reference fails to teach or suggest the non-emulsion gel containing substantially no oil, and thus, that the '420 reference fails to teach or suggest the present invention.

In addition, Applicants address the non-obviousness of the present invention in view of the '420 reference in combination with U.S. Patent No. 5,424,070 ("the '070 reference"). The Examiner's position that these references in combination render the present invention obvious is based on the substitution of sodium behenate, taught in combination with numerous other fatty acid soaps, with sodium stearate taught in the '420 reference. However, there is no basis for this substitution in the context of gel compositions. First, the '070 reference is devoid of any suggestion to make a substitution of this kind. In the '070 reference, 5 different fatty acid soaps, including sodium stearate and sodium behenate, *inter alia*, are combined to make a gel-forming agent. In the Advisory Action, the Examiner relies on the close structural similarity of the 2 compounds to support their equivalence. While Applicants do not address the issue of structural similarity, Applicants point out that there is no teaching or suggestion in the '070 reference that individually either of these two fatty acid soaps are capable of acting sufficiently to form a gel. Rather to the contrary, the '070 reference suggests precisely the opposite because there would be no need to combine a grand total of 5 fatty acid soaps if one would work just fine. Thus, the teaching in the '070 reference of combining 5 fatty acids to make a gel-forming agent, falls far short of teaching or suggesting that individually any one of the fatty acids is equivalent to the other with respect to the formation of gels, and as discussed in Applicants' Previous Response, the '070 reference, therefore, fails to teach or suggest the non-emulsion gel compositions of the present invention comprising a sodium behenate with the other components.

The present invention is a non-emulsion gel composition comprising an aliphatic polyhydric alcohol, an alkali salt of a fatty acid ester, a carbohydrate-based or sterol-based surfactant/emulsifier or combination thereof, water and substantially no oil. As presented above, the '420 reference, alone or in combination with the '070 reference, fails to teach or suggest the present invention, and Applicants request that any §103 rejection be withdrawn.

CONCLUSION

Applicants believe, based on the remarks provided above in the present submission, that the present claims are in condition for allowance, and therefore, a Notice of Allowance for the present claims is respectfully solicited.

Respectfully submitted,

Date: January 22, 2002



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Examiner: Berman, Alysia GROUP 1600

For: Gel-Type Oil Free Cosmetic

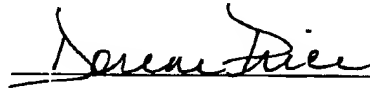
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2. APPLICATION IDENTIFICATION:

(Provide at least enough information to identify the application)

a. For prior application

Application No.: 09/441,832
Filing Date: November 17, 1999
Title: Gel-Type Oil Free Cosmetic
Attorney Docket No.: 2870/192
First Named Inventor: Clement Lawson

b. For instant CPA application

New Attorney Docket No.: 98.41 CON
(If applicable)

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